

Remarks

Claims 1-11 were pending in the above-identified application when last examined and are presented for reconsideration and allowance.

In the Drawings

Applicants have amended Figs. 1 and 3 to include the label "Prior Art." In addition the attached replacement sheets are labeled "Replacement Sheet."

In the Specification

A paragraph making reference to Figure 5 is added after paragraph [0009]

Claim Rejection under 35 U.S.C. § 102

The examiner rejected claims 1- 2 and 7-9 under 35 U.S.C. § 102(b) as being anticipated by Doh et al. (EP , 187 373 A2, hereinafter "Doh").

With regard to claim 1, Doh discloses, in Fig. 1, two separate and independent gain stages. The first gain stage, 12, is a low noise amplifier and the second gain stage, 13, is a limiting amplifier. An embodiment of this invention teaches the use of a clock data recovery block ("CDR") instead of using a second gain stage as shown in Fig. 1 of

Doh. Because claim 1 does not require more than one gain stage, claim 1 is believed to be allowable.

For at least the above reason, Applicants request reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 102(b).

Furthermore, dependent claim 2 further defines patentably distinct independent claim 1. Therefore, Claim 2 is also believed to be allowable. For at least this reason, Applicants request reconsideration and withdrawal of the rejection of claim 2.

With regard to claim 7, Doh discloses, in Fig. 1, two separate and independent gain stages. The first gain stage, 12, is a low noise amplifier and the second gain stage, 13, is a limiting amplifier. An embodiment of this invention teaches the use of a clock data recovery block ("CDR") instead of using a second gain stage as shown in Fig. 1 of Doh. Because claim 7 does not require more than one gain stage, claim 7 is believed to be allowable.

For at least the above reason, Applicants request reconsideration and withdrawal of the rejection of Claim 7 under 35 U.S.C. § 102(b).

Furthermore, dependent claims 8 and 9 further define patentably distinct independent claim 7. Therefore, Claims 8 and 9 are also believed to be allowable. For at least this reason, Applicants request reconsideration and withdrawal of the rejection of claims 8 and 9.

Claim Rejection under 35 U.S.C. § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doh. Applicants respectfully traverses this rejection.

Dependent claim 3 further defines dependent claim 2. Dependent claim 2 further defines patentably distinct independent claim 1. Therefore, Claim 3 is also believed to be allowable. For at least this reason, Applicants request reconsideration and withdrawal of the rejection of claim 3.

Examiner rejected Claims 4-6 and 10-11 under 35 U.S.C. 103(a) as being unpatentable over Doh and further in view of Swenson et al. (U.S. Patent Application Publication No. US 2005/0191059 A1, hereinafter, "Swenson"). Applicants respectfully traverses this rejection.

Concerning Claim 4, appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the rejection, the Examiner asserts that all of the elements of appellants' claim 4 can be found in the prior art references. This, however, is *not* the proper test for obviousness.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

...it would have been obvious to one of ordinary skill in the art to include such a compensation circuit in the receiver of Doh. One of ordinary skill in the art would have been *motivated to do this to compensate the degradation of low-cost low speed components*, such as the transimpedance amplifier...

(Office action, page 4, emphasis added)

The italicized words above represent the Examiner's only explanation regarding a teaching or suggestion to combine. These words, however, are simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

In addition the Examiner's argument regarding obviousness with respect to claim 4 is as follows:

...it would have been obvious to one of ordinary skill in the art to arrange the compensation circuit of Doh in view of Swensen to have a second frequency response that is approximately the inverse of the first frequency response of the transimpedance amplifier circuit. One of ordinary skill in the art would have been motivated to do this since *it is generally known that compensation/equalization using the inverse frequency response of a component/channel provides flat, clean signal results that signify the removal of degradation of that component/channel*.

(Office action, page 5, emphasis added)

The italicized words above represent the Examiner's only explanation regarding a teaching or suggestion to combine. These words, however, are simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of Claim 4 under 35 U.S.C. § 103(a).

The Examiner indicates (page 5 of Office Action) that Claim 5 is rejected as being unpatentable over Doh in view of Swenson because an equalizer is shown in Fig. 3 in view of paragraph [0072]. Neither Doh nor Swenson individually or combined teach or suggest interposing the transimpedance amplifier circuit and the CDR circuit, wherein the compensation circuit is an equalizer. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of Claim 5 under 35 U.S.C. § 103(a).

The Examiner indicates (page 5 of Office Action) that Claim 6 is rejected as being unpatentable over Doh in view of Swenson because he considers filter(s) 605 and/or 610 to synthesize a compensating signal. Neither Doh nor Swenson individually or combined teach or suggest an equalizer that includes a synthesis filter. In order to

establish a *prima facie* case, a teaching or suggestion to combine must be found in the prior art. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of Claim 6 under 35 U.S.C. § 103(a).

The Examiner indicates (page 5 of Office Action) that Claim 10 is rejected as being unpatentable over Doh in view of Swenson for the same reasons he gave in Claim 4.

Concerning Claim 10, appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the rejection, the Examiner asserts that all of the elements of appellants' claim 4 can be found in the prior art references. This, however, is *not* the proper test for obviousness.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to arrange the compensation circuit of Doh in view of Swensen *to have a second frequency response that is approximately the inverse of the first frequency response of the transimpedance amplifier circuit.*

(Office action, page 5, emphasis added)

The italicized words above represent the Examiner's only explanation regarding a teaching or suggestion to combine. These words, however, are simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

The Examiner indicates (page 5 of Office Action) that Claim 11 is rejected as being unpatentable over Doh in view of Swenson because an equalizer is shown in Fig. 3 in view of paragraph [0072]. Neither Doh nor Swenson individually or combined teach or suggest interposing the transimpedance amplifier circuit and the CDR circuit, wherein the compensation circuit is an equalizer. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of Claim 11 under 35 U.S.C. § 103(a).

Conclusion

Applicants respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested.

Respectfully submitted,

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/John Pessetto/

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